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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,620	03/12/2001	Glen McLean Harris	HARR-005	3164

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Michael S. Neustel  
Suite No. 4  
2534 South University Drive  
Fargo, ND 58103

EXAMINER
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AKLILU, KIRUBEL

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/804,620	HARRIS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kirubel Akilu	2614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3/12/2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/11/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/04;4/04;12/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The disclosure is objected to because of the following informalities: Line 27 on page 11 is referring to the electronic system as 110, which is assumed to be 100.  
  
Appropriate correction is required.
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 18 (a) discloses "initializing" of event data however "initializing" is not properly defined in the specification.

### ***Drawings***

1. The drawings are objected to because the decision box "Is TV On?" in Fig. 14 has two "Yes" outputs and no "No" output. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or

figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 09/804619. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The Applicant is notified that a provisional statutory double-patenting rejection will be made on the copending application number 09/804619.

3. The subject matter of claims 1-9 can be found in corresponding claims 1-9 of application 09/804619.
4. **Claim 1** of the present application is encompassed by claims 1-2 of the application 09/804,619.
5. The limitations of **Claims 3-9** of application 09804620 fall within the limitations of Claims 3-9 of application 09804619, and are rejected accordingly.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2614

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by

Darbee et al (US Patent # 6,130,726).

1. In regards to **Claim 1**, Darbee teaches a passive media content access system, comprising:
  - a **control station** (See col. 10 line 29 "... to be transmitted to an associated set-top converter box and on to a given **content provider or host system**");
  - a **housing** (see Fig. 1, col. 6 lines 53-58, Abstract "The remote control device may comprise a housing ...");
  - an electronic system (see col. 2 lines 51-55 "... a remote control unit that is provided with a bidirectional communication capability and with intelligence for monitoring program selection data entered into the unit by a user") capable of storing (see col. 10 lines 14-18 "... it is possible for the software application running on the remote control unit **10** to obtain and cause to be **stored** in memory data ...") and uploading (see col. 10 lines 24-29 "It is also possible for the software application running on the remote control selection history

data . . . to be **transmitted** to an associated set-top converter box and on to a given content provider or host system) event data relating to at least one media event, wherein said electronic system contains a current time, current date, current device (see col. 10 lines 20-23 "In embodiments where the remote control unit **10** is used in conjunction with a personal computer or web computer, the data stored may also include an internet address or URL designation stamp") and current channel; (see col. 10 lines 18-20 "The data stored may include for example, a date stamp, time stamp and/or channel identification data.);

a communication device connected to said electronic system for uploading said event data to said control station (see col. 10 lines 29-32 "Alternatively, such an information transfer might be effected using an IR or RF link to a personal computer using a more conventional modem port.");

an input means connected to said electronic system (see Fig. 1 unit 15; col. 6 lines 52-61 ". . . the remote control device 10 may include . . . a keyboard 15 including volume Up and Down key . . .").

2. As for **Claim 2**, Darbee teaches the passive media content access of Claim 1, wherein said input means includes a keypad (see col. 4 line 14-15 "a keypad provided on the face of the remote control.").

3. As for **Claim 3**, Darbee teaches the passive media content access of Claim 1, wherein said input means includes a display (see Fig. 1 unit **14**; col. 6 lines 52-54 " . . . the remote control device **10** may include on a top panel **12** therefor a LCD visual display **14** . . .").
4. As for **Claim 4**, Darbee teaches the passive content access system of Claim 3, wherein said electronic system is capable of receiving user preference data relating to personal preference (see col. 3 lines 58-64 " . . . it may be an object for the remote control to store only a subset of available program guide and/or advertising information. The subset can be limited for example, to specific channels, specific areas of interest, specific genres of programming, or specific times.").
5. As for **Claim 5**, Darbee teaches the passive media content access system of Claim 4, wherein said control station is in communication with a plurality of programming stations (see col. 9 lines 21-22 "The database for the guide which is broadcast to a given region preferably will cover all of the television stations . . .") for receiving updated media event information (see col. 9 lines 16-18 " In one such embodiment, new program guide data might be provided to the remote control unit **10** . . .").
6. As for **Claim 6**, Darbee teaches the passive media content access system of Claim 5, wherein said control station compares said



event data to said media event information to determine what type of information to send to said user (see col. 10 lines 32-43 "once data indicative of the particular viewing habits, content selection characteristics or interests of a particular remote control user or group of users is transmitted to the content provider or host system, the content provider or host system may tailor additional programming, advertising, or other content to be provided to the remote control unit 10."). The examiner is interpreting the "said event data" to be "content selection characteristics or interests of a particular remote control use, and "media event information" to be the additional programming, advertising, or other content to be provided to the remote control unit 10. And in the process of tailoring the additional programming, advertising, and other content to the user, the content provider inherently has to compare the selection characteristics on interests of a particular remote control with media event information.

7. As for **Claim 7**, Darbee teaches the passive media content of Claim 6, wherein said control station is programmable by said user to reflect said personal preference (see col. 3 lines 31-49 "... advertising and programming data may be selectively downloaded to and stored within the remote control based on preferences of the user.").

8. As for **Claim 8**, Darbee teaches the passive media content access system of Claim 7, wherein said personal preference includes type of information to receive relating to said media event (see col. 3 lines 58-64 “. . . it may be an object for the remote control to store only a subset of available program guide and/or advertising information. The subset can be limited to specific channels, specific areas of user interests, specific genres of programming, or specific times”). The examiner is interpreting “types of information” to mean types of channels, types of areas of user interest, types of genres of programming, and types of information that may be broadcast at different times. Therefor, the personal preference the user specifies includes type of information to receive relating to said media event.
9. As for **Claim 9**, Darbee teaches the passive media content access system of Claim 8, wherein said communication device is in communication with said control station via a global computer network (see col. 4 lines 19-32 “in some embodiment of the present invention, traditional broadcast sources such as cable, satellite and network broadcast channels may be bypassed and alternative data links to the remote control may be provided . . . including wireless and non-wireless links to the Internet.”).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee (US Patent # 6,130,726) in view of Alexander (US Patent # 6,177,931).

10. As for **Claim 10**, Darbee teaches a method of using a passive media content access system having an electronic system with a communication device and an input device, wherein said communication device is in communication with a control station, (all limitation above fall within the limitations of Claim 1). Darbee also teaches:

(b) logging an event data within said electronic system, wherein said event data is comprised of a current date, a current time, a current device (see Darbee col. 10 lines 20-23 "In embodiments where the remote control unit **10** is used in conjunction with a personal computer or web computer, the data stored may also include an internet address or URL designation stamp") and a

current channel at the time of logging said event data (see Darbee col. 10 lines 18-20 "The data stored may include for example, a date stamp, time stamp and/or channel identification data.).

However, Darbee fails to teach said method comprising the steps of:

(a) changing a device setting relating to a media event. Alexander however teaches a method of changing a device setting relating to a media event (see Alexander col. 9 line 65 to col. 10 line 12 "The EPG provides the viewer with the opportunity to select program titles, scheduled for delivery at future times, to watch. By selecting program titles, the viewer builds a "watch list" . . . Instead of automatically recording the program selected, the Watch Function automatically turns the television on, if it is not already on, and automatically tunes the television to the channel scheduled to deliver the designated program, if the television is not already tuned to that channel."). User profile can be created by passively monitoring the user interaction with the Electronic Program guide such as changing channels or changing volume setting of the television set (see Alexander col. 28 lines 30-52 "when the viewer changes channels, the EPG records, among other things, information about the first channel, the changed-to-channel, the

programming . . .”) and this user profile can be used in creating the “Watch list” (see col. 31 lines 25-33 “At the viewer’s option, the EPG and Profile program use the basic viewer profile data, the simple statistics collected about a particular viewer . . .to populate the Record List and/or the Watch List . . .”). In view of the teaching of Alexander, it would have been obvious to one of ordinary skill in the art at the time this invention was made to modify the electronic program guide of Darbee to comprise changing a device setting relating to a media event. One of ordinary skill would have been motivated to do this to provide the viewer with the opportunity to watch a program of special interest at the scheduled time even if the viewer has forgotten about the scheduled delivery (see Alexander col. 10 lines 7-10).

11. As for **Claim 11**, Darbee teaches the method of using a passive media content access system of Claim 10, including the step of:  
(c) uploading said event data to said control station (see col. 10 lines 24-29 “It is also possible for the software application running on the remote control selection history data . . .to be **transmitted** to an associated set-top converter box and on to a given content provider or host system).
12. As for **Claim 12**, the method of using a passive media content access system of Claim 11, including the steps of:

(d) determining an identity of said media event from said event data;

the above limitation (d) is analyzed with respect to claim 10.

Alexander teaches a method of using a user profile to create a "watch list" wherein the Electronic Program Guide uses event data (the viewer viewing habits such as channels watched and times when said channels are watched. See col. 28 lines 30-52) to create a user profile, which in turn may be used to create the "watch list" (see Alexander col. 31 lines 25-33). The examiner is interpreting the steps of creating a watch list of channels based on information collected from the viewer's viewing habits as determining an identity of said media event from said event data.

(e) determining whether information is available regarding said media event (see Darbee col. 10 lines 38-43. "the serial number, address and/or user information maintained within the memory of the remote control unit 10 may be used to filter and/or parse data, including programming information, advertising or other content . . .").

13. As for **Claim 13**, Darbee teaches the method of using a passive media content access system of Claim 12, including the step of:

(f) providing available information to said user (see col. 10 lines 32-38 "once data indicative of the particular viewing habits, content

selection characteristics or interests of a particular remote control user is transmitted to the host, the host system may tailor additional programming, advertising, or other content to be provided to the remote control unit 10).

14. As for **Claim 14**, the claim differs from Darbee in that it further requires the method of using a passive media content access system of Claim 13, including the step of:  
  
(g) sending an e-mail containing said available information to said user. Darbee does however teach that “. . . traditional broadcast sources such as cable, satellite and network broadcast channels may be bypassed and alternative data links to the remote control may be provided . . . such as wireless and non-wireless links to the internet” (see col. 4 lines 26-32). It is well known in the art that e-mail is a prominent means of sending information when Internet communication is available. Email is an attractive means of communication because the recipient has the option of accessing the email message at his/her convenient time. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Darbee's means of providing available information to the user to be of an e-mail format. One would have been motivated to do this when Internet access was available between the remote control unit and the host system and

the user can access the email message at a time that is convenient to him/her.

15. As for **Claim 15**, Darbee teaches the method of using a passive media content access system of Claim 12, including the step of:
- (f) providing available information depending upon predefined user preference (see col. 10 lines 32-38 "once data indicative of the particular viewing habits, content selection characteristics . . . is transmitted to the content provider or host system . . . host system may tailor additional programming, advertising or other content to be provided to the remote control unit 10.").
16. As for **Claim 16**, the method of using a passive media content access system of Claim 10, including the steps of:
- (c) determining at least one favorite media event based upon said event data;. The above limitations fall within the limitation of Claim 12 and are rejected accordingly
- (d) setting a reminder for said at least one favorite media event to alert a user to the upcoming event. This limitation falls within the limitation of Claim 10 and is rejected accordingly.
17. As for **Claim 17**, the method of using a passive media content access system of Claim 16, including the steps of:



(e) determining whether proper device states are in effect for said at least one favorite media event; this limitation falls within the limitation (a) of claim 10 and is rejected accordingly.

(f) switching at least one external electronic device to a proper device state if not in said proper device state. This limitation falls within the limitation (a) of claim 10 and is rejected accordingly.

18. As for **Claim 18**, a method of using a passive media content access system having an electronic system with a communication device and an input device, wherein said communication device is in communication with a control station, said method comprising the steps of:

(a) initializing a current date, a current time, a current device and a current channel into said electronic system; These limitations fall within the limitation (b) of claim 10 and are rejected accordingly.

(b) changing a device setting relating to a media event; This limitation falls within the limitation (a) of claim 10 and is rejected accordingly; and

(c) logging an event data within said electronic system, wherein said event data is comprised of a current date, a current time, a current device and a current channel at the time of logging said event data. This limitation falls within the limitation (b) of claim 10 and is rejected accordingly.

19. As for **Claim 19**, Darbee teaches the method of using a passive media content access system of Claim 18, including the step of:  
(d) uploading said event data to said control station. This limitation falls within the limitation of claim 11 and is rejected accordingly.
20. As for **Claim 20**, Darbee teaches the method of using a passive media content access system of Claim 19, including the steps of:  
(e) determining an identity of said media event from said event data;. This limitation falls within the limitations (d) of claim 12 and is rejected accordingly.  
(f) determining whether information is available regarding said media event. This limitation falls within the limitation (e) of claim 12 and is rejected accordingly.

### ***Conclusion***

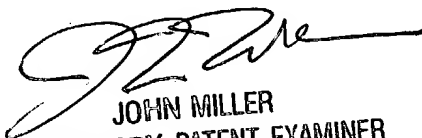
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirubel Aklilu whose telephone number is 703-305-8144. The examiner can normally be reached on 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 703-305-4795. The

fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KA  
November 8, 2004

  
JOHN MILLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600